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| 09/227,344 | 01/08/99 | SCHOFIELD | K 690.2200-PCT |

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EXAMINER

SIKDER, M

| ART UNIT | PAPER NUMBER |
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2872

DATE MAILED: 09/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/277,344

Applicant(s)

Schofield et al.

Examiner
Mohammad Y. Sikder

Group Art Unit
2872



☒ Responsive to communication(s) filed on Jan 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-92 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-92 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

ACKNOWLEDGMENT

This application which is a CIP of PCT/US94/01954 and a CIP of 08/023,918, now Patent No. 5,550,677 is acknowledged.

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

2. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means"

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and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. **Claims 1-14, 16, 34, 39-52, 54, 56-57, 59-77, 81-87 are rejected** under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14, 16, 34, 39-52, 54, 56-57, 59-77, 81-87 of prior U.S. Patent No. 5,550,677. This is a double patenting rejection.

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6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 15, 17-33, 35-38, 53, 55, 58, 78-80 are rejected** under the judicially created doctrine of double patenting over claims 15, 17-32, 33, 35-37, 53 of U. S. Patent No. 5,550,677 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the signal processor samples the electrical signals indicative of the sensed light levels at a substantially constant sampling rate, said at least one variable reflectance rearview mirror comprises a plurality of segments, said signal processor determines the first electrical signal indicative of the background light level, said signal processor determines the second electrical signal indicative of at least peak light level, said photosensor array means comprises a plurality of photosensor element generating a photosensor element signal indicative of a light level of light incident thereon.

8. **Claims 88-91 are rejected** under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 5,877,897 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

a) A control system for controlling at least one variable reflectance mirror comprising a photosensor array means, first determining means coupled to said photosensor array means,

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second determining means coupled to said photosensor array means, memory means coupled to said second determining means,

b) A vehicle intrusion detection system for detecting movement within a vehicle interior comprising photosensor array means, determining means coupled to said photosensor array means, comparing means coupled to said determining means,

c) A compartment image data storage system for a vehicle comprising photosensor array means, determining means coupled to said photosensor array means, memory means coupled to said determining means,

d) An automobile rear view mirror system comprising a variable reflectance rearview mirror, a signal processing means for receiving said photosensor array signals, a mounting bracket means for attaching said variable reflectance rearview mirror.

9. **Claim 92 is rejected** under the judicially created doctrine of double patenting over claims 1, 5 of U. S. Patent No. 5,794,094 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A vehicle lighting control system comprising a photosensor array means, a signal processing means coupled to said photosensor array means.

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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11. **Claim 92 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Hegyi (5,416,318).

Hegyi (5,416,318) shows (see fig. 4) a vehicle lighting control system for controlling a vehicle lighting system in an automotive vehicle comprising a photosensor means 10 for sensing light levels in a forward field of view and generating a set of photosensor array signals; and a signal processing means 20 coupled to said photosensor means 11 for receiving said set of photosensor array signals and determining from said set of photosensor array signals at least one control signal for controlling said vehicle lighting system 21.

Thus, Hegyi (5,416,318) discloses the invention substantially as claimed except for an array of photosensor means.

Regarding the features of an array of photosensor means, Official Notice is hereby taken that it is obvious in the photo-optical system to provide multiple photosensor means to improve sensing the surrounding light of the vehicle. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Hegyi (5,416,318) such that the array of photosensor means is provided in the control system of vehicle lighting to improve sensing the surrounding light, and thereby improving controlling the headlamps of the vehicle.

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CONTACT INFORMATION

Papers related to this application may be submitted to Group 2870 by facsimile transmission. Papers should be faxed to Group 2870 via the PTO Fax center located in the Crystal Plaza 4. Faxing of such papers must conform with the notice published in the official Gazette, 1096 OG 30 (November 15, 1989). The CP-4 Fax Center number is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application should be directed to M. Sikder whose telephone number is (703) 305-5471.


M. Sikder

August 20, 1999